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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,837	09/09/2003	Mark A. Reiley	10002-701.406	1759

66854 7590 09/08/2009  
SHAY GLENN LLP  
2755 CAMPUS DRIVE  
SUITE 210  
SAN MATEO, CA 94403

EXAMINER
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PRONE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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09/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/657,837	<b>Applicant(s)</b> REILEY, MARK A.	
	<b>Examiner</b> CHRISTOPHER D. PRONE	<b>Art Unit</b> 3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,10 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11-19 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In view of the Appeal Brief filed on 5/23/07, PROSECUTION IS HEREBY REOPENED. A New Rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) File a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738.

### **Status of Claims**

Prior to this action the claims filed after final on 12/18/06 were not entered. The claims filed with the appeal brief were new set including 101 problems in claims 24 and 25 that were amended out of the claims filed on 6/12/06. To eliminate the confusion the claims sent filed after final on 12/18/06 is being entered and examined.

***Election/Restrictions***

Claims 3, 7, 10, 20-22 remain withdraw.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 8, 9, 11, 12, 16, 24, 25, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 4 recite that the structure is “fixed to the fastening element”, but their dependency roots from claim 1 which recites that the structure is “removably attached to the fastening element”. It is unclear how the two components can both be fixed and removably attached at the same time.

Claims 8, 9, and 11, recite that the facet joint surface comprises an insert fitted into the structure, which the specification defines as element 321, but then it is unclear what the applicant is calling the structure. The elected embodiment is figure 2b which is defined by the specification as inserting into the fastening element of figure 2a. But this leaves no element left to be called the structure. Is the applicant calling the upper portions 315a or 311a of the stem the structure? If so how it is removably attached from the fastening element 310a?

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Claim 12 recites that the structure pivots with respect to the fastening element, but it is clear from figures 2a and 2b that once the structure from figure 2b is attached to the structure of 2a the only thing pivoting would be what is engaging the outer surface. The fastening element and structure of the figures would be locked into their positions.

Claims 16 and 28 recite that the prosthetic facet joint articulating surface is made of at least "one selected prosthetic material," but the claims fail to define what materials are selected. Applicant is advised to cancel claims 16 and 28 then to amend claims 17 and 29 to correct their dependency and eliminate and 112 lack of antecedent problems.

Claims 24 and 25 recite wherein the fastening element "is to the vertebra". It is unclear what the applicant intends by this wording. Does the applicant intend the fastening element to be fastened to? Adjacent to?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-6, 8, 9, 11-17, 19, and 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Zang et al (USPN 5,314,486)

Zang, et al discloses a prosthesis comprising a fastening element, and an artificial joint structure comprising a facet joint surface carried by the fastening element.

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The prosthesis of Zang, et al is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

While the prosthesis of Zang, et al is intended for replacement of a phalangeal type joints, the structure as broadly claimed is fully met by the prosthesis of Zang, et al. The prosthesis of Zang, et al is structurally similar to that as illustrated by applicant and the applicant has failed to provide any factual evidence why the device of Zang could not perform the intended task. Therefor, examiner contends that the device of Zang et al is capable of performing the function of replacing all or a portion of the natural facet joint. A side by side view of the applicant's invention and the device of Zang are included below to show the structural similarities.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

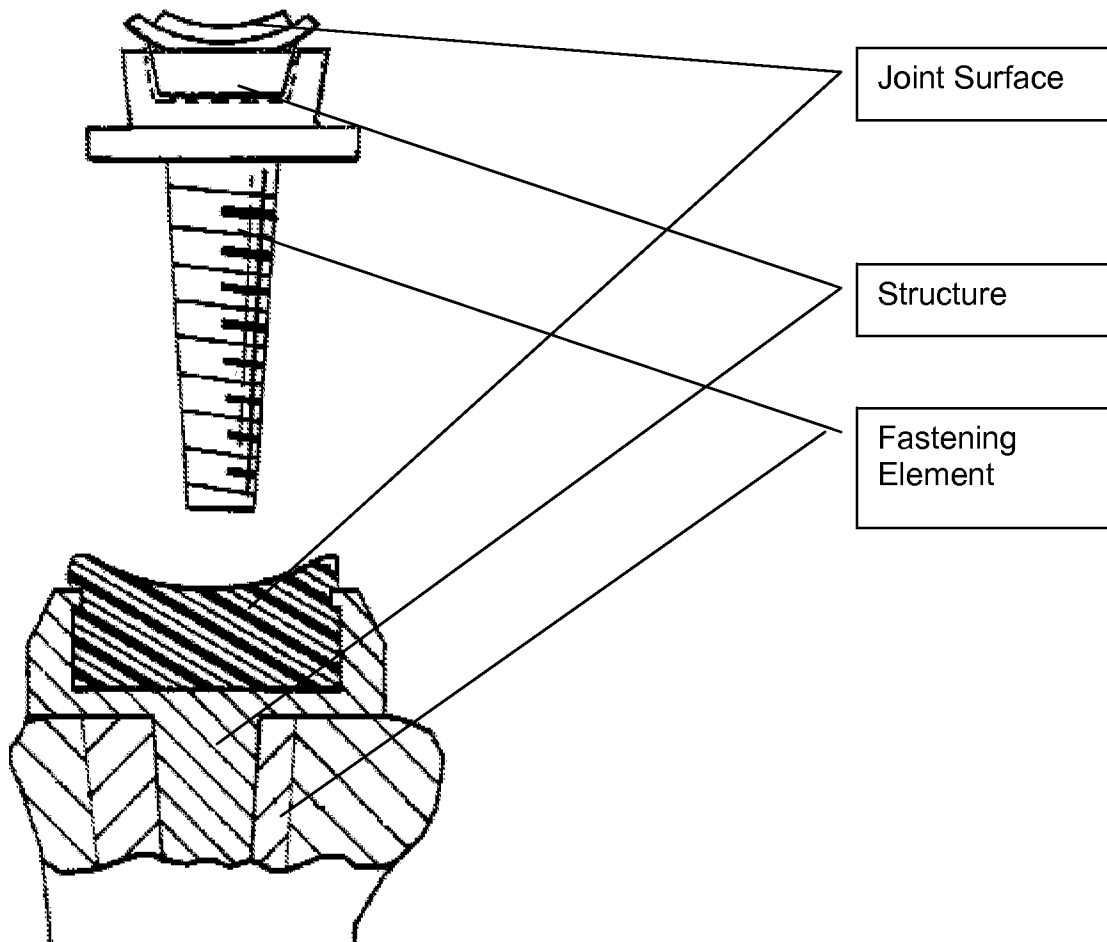
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zang et al (USPN 5,314,486).

The combination of the fastening element and the facet joint structure of Zang et al is described above as being attached with mechanical means. It is well known in the art of fabricating elements to fastening joint structure using adhesives, Adhesives and

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mechanical fasteners are well known within the art to be interchangeable components for affixing elements together. The two are essentially known equivalents in the art.



### ***Response to Arguments***

The prosthesis of Zang, et al is structurally similar to that as illustrated by applicant and the applicant has failed to provide any factual evidence why the device of Zang could not perform the intended task. Therefor, examiner contends that the device of Zang et al is capable of performing the function of replacing all or a portion of the natural facet joint.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738